

REMARKS/ARGUMENTS

Claim Objections

The Examiner objected to Claims 13, 14, 9 and 11 with respect to those claims having a lack of antecedent basis and by for foregoing amendments it is believed that these bases of objection have now been obviated.

Claim Rejections – 35 USC § 102

The Examiner has rejected Claims 1, as being anticipated by Slawinski (U.S. 6,293,892) and has further rejected on the same Slawinski reference Claims 12 and 16.

The Examiner is reminded that Applicant's invention comprises an exercise device as noted by the Examiner, which has a unique configuration for achieving specific movement functions with respect to a weight. Slawinski does not meet the limitations of the claims, especially as now amended, with respect to having a freeweight connecting member being pivotally connected to a first pivot for forward and backward movement relative to the supporting structure nor a second pivot as called for by the claims and as clearly shown in the drawings. Furthermore, it is not seen that Slawinski's structure would allow for movement as contemplated by Applicant's invention and as now clearly defined by the claims. The Examiner is requested to reconsider his position in this regard.

The Examiner next rejected Claims 1-6, 9-13 and 21-23 under 35 USC §102(b) as being anticipated by Einsig (U.S. 5,813,951). The Examiner is referred to the Einsig reference and, more specifically the drawings from which it will be noted that

Einsig does not meet the limitations as clearly brought out in the amended claims of having first and second pivots for achieving the movement of an exercise device as is contemplated by Applicant. It is submitted that Claim 1 patentably distinguishes over both Einsig and Slawinski and that the claims dependent therefrom are also patentably distinguishable.

Claim Rejections – 35 USC § 102

Claim 16 was rejected under U.S.C. 103(a) as being unpatentable over Einsig but it is submitted that Claim 16 depends on Claim 1 which as noted hereinbefore has been amended to patentably distinguish over Einsig and any of the other references of record.

Allowable Subject Matter

The Examiner has indicated that Claims 7-8, 14-15, and 17 would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. The Examiner will note that newly submitted claims 24, 25 and 26 are the indicated allowable claims rewritten in independent form and it is submitted that these claims are also allowable.

Newly added Claim 27 is also believed to be patentable over the prior art because it encompasses the subject matter, which the Examiner has explicitly indicated in paragraph 21 of the Office Action as comprising allowable subject matter over the prior art.

Thus, the claims as amended are not and could not be anticipated by the applied references. Further, the Examiner is requested to reconsider his rejection of Applicant's invention in view of the prior art. The Court of Appeals for the Federal Circuit (CAFC) has ruled that it is improper to reconstruct an applicant's invention on the basis of the applicant's total disclosure. In the present case, there is no disclosure or suggestion in the Slawinski and Einsig patents relied on by the Examiner from which the invention claimed by Applicant may be constructed. Indeed, even in light of Applicant's own teaching, the Examiner would be unable to reconstruct, from the cited references, an invention which meets the language of the present claims.

The Examiner cannot, in the absence of some suggestion or teaching in the references, simply combine references in an attempt to show that an applicant's claims are obvious. Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, 1394 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1988). The CAFC has indicated that two questions are to be asked when a combination of references is relied upon to reject a claim:

- (1) whether a combination of the teachings of the references would have suggested (expressly or by implication) the possibility of achieving further improvement along the lines of the claimed invention; and
- (2) whether the claimed invention has achieved more than a combination which any or all of the prior art references suggested.

In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983).

The Court emphasized that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining these teachings. Something more than merely finding each element of the combination in the references is required, and here the Examiner has not even found that.

Applicant submits the Examiner has failed to demonstrate that the answer to either question should be decided against Applicant. None of the references, alone or in combination, disclose or suggest that combination of elements recited in Applicant's present claims. As such, Applicant's claims all go beyond that which has been achieved before and are not reflected by any reasonable combination of the prior art references.

Further, the Examiner has pointed to nothing in any of the references that suggests combining their teachings. The Examiner has unsuccessfully tried to cull from the cited references specific elements claimed by Applicant, based on Applicant's own teaching and not on those teachings set forth in the cited references.

Finally, the subject matter of the invention as a whole must be considered. Even though features may be disclosed in the prior art, performing their ordained and expected function, the test is whether the claimed invention as a whole, in light of all of the teaching of the references in their entireties, would have been obvious to one of ordinary skill in the art. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220

U.S.P.Q. 193, 199 (Fed. Cir. 1983). Thus, it is clear that, in light of decisions of the CAFC, the Examiner has not met the CAFC's tests in combining references.

A reference is only good for what it clearly and definitely discloses. In re Moreton, 288 F.2d 708, 129 U.S.P.Q. 227, 230 (C.C.P.A. 1961); In re Hughes, 345 F.2d 184, 145 U.S.P.Q. 467, 471 (C.C.P.A. 1965). Furthermore, a patent is not a fair reference where it is not directed to the same purpose and does not involve the same inventive concept. Ex parte Garvey, 41 U.S.P.Q. 583 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1939). Absent a clear disclosure, i.e., an anticipation or some other special statutory prohibition, a rejection must stand or fall on the existence of obviousness as qualified in 35 U.S.C. §103. In re Murray et al., 268 F.2d 226, 122 U.S.P.Q. 364, 367 (C.C.P.A. 1959).

It is submitted that the claims under discussion are not anticipated or obvious in view of the other references of record. The amended claims patently define over each of the references, either individually or taken in any reasonable combination.

A combination of references is improperly applied where there is no suggestion by any of the references of the problem involved or where the solution to the problem is neither indicated nor taught. In re Shaffer, 229 F.2d 476, 108 U.S.P.Q. 326, 329 (C.C.P.A. 1956). When references are combined, it should be considered whether the references suggest a thing which the applicant has done. In re Gruskin, 234 F.2d 493, 110 U.S.P.Q. 288, 292 (C.C.P.A. 1956). Moreover, references may not be combined where there is no suggestion in either of the references that they can be combined to

meet the recitation of the applicant's claims. In re Hortman, 264 F.2d 911, 121 U.S.P.Q. 218, 220 (C.C.P.A. 1959); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984); see also Ex parte Hiyamizu, 10 U.S.P.Q.2d 1393, 1394 (Pat. and Trademark Off. Bd. of Pat. App. and Interferences 1988).

Whether a combination of references negates patentability depends solely upon what the references would reasonably and realistically teach those of ordinary skill in the art. In re Free, 329 F.2d 998, 141 U.S.P.Q. 238, 240 (C.C.P.A. 1964); In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1, 5 (Fed. Cir. 1983). What the Examiner is attempting is a piecemeal construction of the prior art in view of the Applicant's own disclosure in order to negate the present invention. The law clearly does not sanction this procedure. In re Rothermel et al., 276 F.2d 393, 125 U.S.P.Q. 328, 331 (C.C.P.A. 1960); In re Kamm & Young, 452 F.2d 1052, 172 U.S.P.Q. 298, 301 (C.C.P.A. 1972); W. L. Gore & Assoc. v. Garlock, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

As the CAFC has stated in Environmental Designs, Ltd. et al. v. Union Oil of Cal. et al.;

"Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art . . . "

713 F.2d 693, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983), cert. denied, 104 S. Ct. 709, 224 U.S.P.Q. 520 (1984).

The CAFC has ruled that it is improper to reconstruct an applicant's invention on the basis of the applicant's total disclosure. There is no teaching or suggestion in either the Slawinski or Einsig or other references relied on or cited by the Examiner from which the invention claimed by Applicant can be constructed. In In re Newell, 891 F.2d 899, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989) the Federal Circuit Court stated:

. . . a retrospective view of inherency is not a substitute for some teaching or suggestion [in prior art] which supports selection and use of the various elements in particular claimed combination. . . . It is well established that in deciding that a novel combination would have been obvious, there must be supporting teaching in the prior art.

See also, accord, In re Laskowski, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999), 50 USPQ2d 1614 is even more direct. In this case the applicant sought a patent for a large trash bag decorated with lines and features so that when filled it resembled a Halloween-style pumpkin or jack-o'-lantern.

The prior art showed large trash bags and an activity book showing how to make paper bag pumpkins and jack-o'-lanterns. The CAFC reversed the Board's finding of obviousness stating:

“Because we do not discern any finding by the Board that there was a suggestion, teaching or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand”.

CONCLUSION

It is noted that the Examiner has made part of record but has not relied upon the same, but it is not seen that the cited patents in Paragraph 22 of the Office Action detract from the patentability of Applicant's invention as set forth hereinabove.

Furthermore, with respect to the foregoing amendments and arguments it is clear that Applicant's claims and invention is decidedly different than the two applied references of Slawinski and Einsig, and it is submitted that the application is in condition for allowance and same is respectfully requested.

If the Examiner believes that a telephone or other conference would be of value in expediting the prosecution of the present Application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicant invites the Examiner to contact Applicant's representative at the number listed below.

Application No. 10/053,325
Reply to Office Action of March 18, 2004
Attorney Docket No. 01-9911

A check in the amount of \$208.00 is submitted for the additional claims. In the event any additional fees are due, the Examiner is authorized to charge Applicant's Attorney's Deposit Account No. 03-2030.

Respectfully submitted,

CISLO & THOMAS LLP

Date: May 26, 2004


Donald M. Cislo, Reg. No. 22,060

Enclosures: Check/Ack card

CISLO & THOMAS LLP
233 Wilshire Boulevard, Suite 900
Santa Monica, California 90401
Tel: (310) 451-0647
Fax: (310) 394-4477

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